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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,746	02/15/2001	Robert G. Stevens	ARIBP036	2175
21912 7590 10/06/2010 VAN PELT, YI & JAMES LLP 10050 N. FOOTHILL BLVD #200 CUPERTINO, CA 95014				
EXAMINER TINKLER, MURIEL S				
ART UNIT 3691		PAPER NUMBER		
NOTIFICATION DATE 10/06/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptocorrespondence@ip-patent.com

Office Action Summary

Application No.

09/783,746

Applicant(s)

STEVENS, ROBERT G.

Examiner

MURIEL TINKLER

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-16, 18, 19 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-16, 18, 19 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/C2)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This application has been reviewed. The status of the claims are as follows: claims 1, 4-16, 18, 19 and 22 were previously pending; claim 22 has been amended; no claims have been added or cancelled; therefore, claims 1, 4-16, 18, 19 and 22 are currently pending and have been examined. The rejection(s) are as follows.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 22, 2010 has been entered.

Response to Amendment

2. The amendment to claim 22 has been reviewed against the specification and accepted for examination.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10 and 14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 10 recites the limitation "the spot marketplace" in line 2. There is insufficient antecedent basis for this limitation in the claim. The phrase should read as "a spot market place". For the purposes of compact prosecution, the Examiner will interpret "the spot marketplace" as "a spot market place".
6. Claim 16 discloses the phrase, "The method of claim 1, wherein the selecting further comprises". The problem here is that claim 1 has more than one 'selecting' steps. Claim 1 selects potential bidders in lines 7-8 and winning bidders in lines 15-16. For purposes of compact prosecution, the examiner will interpret "the selecting" in claim 16 to read as "selecting the winning bidders."

Response to Arguments

7. Applicant's arguments, see page 6, filed March 22, 2010, with respect to the 35 USC 101 Rejection of claim 22 have been fully considered and are persuasive. The Applicant has successfully amended claim 22 to overcome the rejection. Therefore, the 35 USC 101 Rejection of claim 22 has been withdrawn.
8. Applicant's arguments, regarding the 35 USC 103 Rejection, filed March 22, 2010 have been fully considered but they are not persuasive. The Applicant argues that the prior art does not teach the limitation found in claim 1, which states "a database of information representing the capabilities of suppliers to delivery goods and services to

geographic areas and automatically selecting as potential bidders for an auction those suppliers whose capabilities satisfy at least a portion of the request". The Applicant specifically highlights, the "capabilities" of the vendors on page 7, as not being taught by Giovannoli. The Examiner disagrees. Specifically, what the exact 'capabilities' are is not defined by the specification (see page 5, lines 10-15; page 10, lines 15-20; and page 11, lines 5-10). The Examiner will interpret this limitation to mean that the vendor has the capability to deliver the goods or services to the buyer. The Examiner cites Giovannoli (US Patent 5,758,328) fig. 2A, 4th block and fig. 5 "Qualifying Vendors".

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 8, 9, 10, 15, 16, 18, 19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Giovannoli (US Patent 5,758,328), hereafter referred to as Giovannoli.

11. Regarding claims 1, 9, 18 and 22, Giovannoli discloses:

- a. A method for soliciting and receiving bids, for goods or services necessary to satisfy a spot need of a buyer (Abstract), comprising:

- b. A computer connected to the supplier database (fig. 1, "System Central Computer")
- c. receiving a request to procure goods or services that are required to satisfy the spot need of the buyer (fig. 2A, block 3 "The buyer requests a quotation"),
- d. wherein the request includes information identifying a type of good or service being procured by the buyer, and wherein the request includes geographic information; The Examiner points out that the specification specifically discloses this limitation on page 5 (lines 15-20), "In this embodiment, the spot request from the buyer may further include information identifying a geographic location associated with the goods or services being procured by the buyer." Based on this section of the specification, the Examiner has interpreted this limitation to mean that the request includes the buyers delivery information. Giovannoli discloses that the request includes the buyers delivery information (fig. 7 "Ship Destination"—discloses buyer information which could comprise the request for quote packet, see also column 5, lines 34-36)
- e. querying, using a processor, a database (a vendor's product database, see fig. 4 "Product Database") of information representing the capabilities of suppliers to deliver goods and services to geographic areas and automatically selecting as potential bidders for an auction those suppliers whose capabilities satisfy at least a portion of the request (see column 2, lines 35-51 and column 4, lines 36-49);

- f. electronically notifying each of the potential bidders of an opportunity to submit a bid to satisfy all or part of the buyer's purchase request; conducting the auction that includes electronically accepting bids from those potential bidders that each provide one or more bids before a bidding deadline expires and not accepting the bids after the bidding deadline expires; and automatically selecting one or more winning bidders in accordance with the received bids (see fig. 2A, block 4, "The quotation system processes the request by selecting a class of vendors who sell the requested product(s) and meet the filter requirements of the buyer, vendor, and the quotation system. The quotation system then makes available the request(s) to each selected vendor via file transfer protocol (FTP) or e-mail."
12. Regarding claim 8, Giovannoli discloses: The method of claim 1, wherein the electronically notifying further comprises sending an electronic mail message to each of the selected bidders (see column 2, line 35 through column 3, line 1 and fig. 2A, block 4, "The quotation system then makes available the request(s) to each selected vendor via file transfer protocol (FTP) or e-mail").
13. Regarding claim 10, Giovannoli discloses: The method of claim 1, further comprising posting information about the request on a web page in the spot market place (see column 4, lines 1-9).
14. Regarding claim 15, Giovannoli discloses: The method of claim 1, wherein the selecting further comprises notifying all bidders who posted bids about their status (the

system uses the internet and web pages to keep the buyers and bidders up to date with information, see column 4 (lines 1-9 and 21-26).

15. Regarding claim 16, Giovannoli discloses: The method of claim 1, wherein [[the]] selecting **the winning bidders** further comprises notifying the one or more winning bidders of an award by electronic communications (see fig. 2A, block 4, "The quotation system then makes available the request(s) to each selected vendor via file transfer protocol (FTP) or e-mail).

16. Regarding claim 19, Giovannoli discloses: The system of claim 18, wherein each of the bidders ("Buyer") is electronically coupled (via the "Internet Computer Network") to a spot marketplace ("System Central Computer", see fig. 1).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli as applied to claim 1 above, and further in view of Admitted Prior Art.

19. Claims 4-6, Giovannoli fails to teach a predefined amount of time for completion of the steps of automatically selecting, electronically notifying and electronically selecting a winning bidder. Giovannoli further fails to teach including a bidding time period and a bidding deadline in the electronic communication, and instructing selected vendors to post bids before said deadline.

20. Official Notice is taken that defining the length of time of the auction process, having a bidding time period and a bidding deadline, and the notification of said deadlines is old and well known in the art. Since Applicant failed to adequately challenge Examiner's statement of what is old and well known in the art in a timely manner, as cited in the Office Action dated 9/28/05, the statement of Official Notice is considered admitted prior art. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify the teachings of Giovannoli to include in the method the steps of defining the timeframe under which the steps of automatically selecting, electronically notifying, and electronically accepting a winning bidder must be completed, and of including in said electronic notifications a bidding time period and a bidding deadline, and instructions to post bids before said deadline, as steps may be completed within any predetermined time to accommodate the needs of the buyer, improving the usefulness and convenience of the method. Electronic notification of said deadlines, and instructions for bidders to place bids before said deadlines informs the bidder, making the method easier to implement.

21. Claims 7, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli as applied to claim 1 above, and further in view of Walker (US Patent No. 5,794,207), hereafter referred to a Walker.

22. Claims 7, Giovannoli fails to teach the buyer request may be posted on bulletin boards or web pages. Walker teaches potential sellers are selected by meeting certain conditions set forth by the buyer. Walker teaches the seller submits a counteroffer to the buyer thereby facilitating the buyer to. choose the best counteroffer as the winner of the contract (Figures 5-11 and Column 18 Lines 24-31). Walker further teaches the buyer's request may be posted on bulletin boards or web pages. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Giovannoli to include posting the request on bulletin boards or web pages because posting a single description in a central, universally accessible location such as the internet or a bulletin board would improve the efficiency of the system.

23. Regarding claims 11 and 12, Giovannoli does not disclose including a bidding time period and a bidding deadline in an electronic communication or that the electronically notifying further comprises instructing the selected bidders to post bids before a bidding deadline. Walker discloses a method and apparatus for facilitating and controlling a buyer driven market, where prospective buyers of goods and services submit a request for said goods and services, which is then processed and electronically mailed to potential seller groups (column 18 lines 15-25). Walker teaches the request for proposal (RFP) information being sent to potential sellers, wherein the

RFP information includes an expiration date, after which the RFP becomes expired, and the contract may no longer be binded (column 17 lines 43-47: the expiration is set. An expired CPO is considered equivalent to "not accepting bids"). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Giovannoli to include the expiration date feature of Walker because the environments of Giovannoli and Walker are similar, and it feature of Walker which allows for RFP expirations is desirable, so that an buyer is not bound to purchase an item after a time when the item is no longer needed. The addition of this feature would provide the same benefits in the context of Giovannoli, and one of ordinary skill in the art would recognize that the results are predictable.

24. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli and Walker as applied to claims 11 and 12 above, and further in view of Ausubel (U.S. Patent No. 5,905,975), hereafter referred to as Ausubel.

25. Giovannoli, Walker ('207), Fedor, and Sheth fail to teach instructing the selected bidders to post sealed bids, and instructing selected bidders to post partially open bids in which bidders may revise bids until the deadline passes. However, Ausubel discloses a computer implemented system and method of executing an auction, in which bids are submitted and processed, and a winner selected. Ausubel also teaches sealed bid auctions as a method of conducting the auction, and a method of bidding where bidders are allowed to continuously revise their bids until the close of the auction.

It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify the teachings of Giovannoli and Walker ('207) to include such methods for the bidding process because they are fair, organized, commonly used methods of the auction art, and the addition of the features would achieve predictable results.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 8:30 AM until 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Muriel Tinkler/
Examiner, Art Unit 3691